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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/579,733 | 12/28/1995 | HIROSHI NOBUTA | 862.1351 | 4611 |

5514 7590 08/27/2002

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EXAMINER

WALLERSON, MARK E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2622

DATE MAILED: 08/27/2002

32

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/579,733

Applicant(s)

Nobuta

Examiner

Mark Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 7, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24, 26, 27, 29, 58, and 59 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 26, 27, 29, 58, and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **6/7/2002**.
2. This application has been reconsidered. Claims 24, 26, 27, 29, 58, and 59 are pending.

Continued Prosecution Application

3. The request filed on 6/28/2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/579,733 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no clear disclosure in the original specification of "a second copying mode, performed in sequence in response to a single designation". What sequence? What "single

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designation”? Applicant provided alleged support for this subject matter on page 15, lines 20-23 and page 26, line 6 to page 27, line 1. However, it is unclear to the Examiner what the “sequence” is, and contrary to Applicant’s submission, page 15, lines 20-23 disclose two “designations” - depressing the copy key or the print key and depressing the start/stop key, while page 26, line 6 to page 27, line 1 discloses two separate designations for starting the printer and scanner.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“[A] second copying mode, performed in sequence in response to a single designation” is unclear.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Kita (U. S. 5,021,892).

With respect to claim 27, Kita discloses an image processing device (1) comprising reading an image of a document and outputting an image signal by a scanner (60) (column 3, lines 30-36 and column 5, lines 16-47); a control unit (which reads on 50, 51, 52, 54, 56, and buses (DB, AB, and CB)) including a control circuit (50) for controlling the device (column 4, lines 46-54) and performing necessary image processing on the image signal output from the scanner to provide a first processed image signal (column 5, lines 33-37); a first bidirectional general purpose interface (5) (column 6, lines 20-28) for transmitting the image signal output by the scanner (60) under control of the control unit (50) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); a second bidirectional interface (66) (which reads on for connecting a mechanism), for outputting the first and second signals to a printer (3), wherein the device has a plurality of modes (column 6, line 50 to column 7, line 25) including a first copying mode (which reads on Image Input Function) in which the image signal inputted from the scanner is outputted to the printer using the external computer (8) (column 5, lines 65-68 and column 6, line 65 to column 7, line 7), and a second copying mode (which reads on Copy Function) in which the image signal inputted from the scanner is outputted to the printer without

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using the external computer (column 6, lines 50-55), the image signal from the scanner being automatically transmitted (which reads on under control of the personal computer) (column 6, lines 65-67 and column 23, lines 12-32) in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), first bidirectional interface (5), the external computer (8), the first bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and the second bidirectional interface (66) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)) and the second bidirectional interface (66) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 24 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (U. S. 5,021,892) in view of Kawamata et. al. (hereinafter referred to as Kawamata) (U. S. 4,989,163).

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With respect to claim 24 (as best understood by the Examiner), Kita discloses an image processing device (1) comprising a scanner (60) for reading an image of a document and outputting an image signal (column 3, lines 30-36 and column 5, lines 16-47); a control unit (which reads on 50, 51, 52, 54, 56, and buses (DB, AB, and CB)) including a control circuit (50) for controlling the device (column 4, lines 46-54) and performing necessary image processing on the image signal output from the scanner to provide a first processed image signal (column 5, lines 33-37); a first bidirectional general purpose interface (5) (column 6, lines 20-28) for transmitting the image signal input by the scanner (60) under control of the control unit (50) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); a second bidirectional interface (66) (which reads on for connecting a mechanism), for outputting the first and second signals to a printer (3), wherein the device has a plurality of modes (column 6, line 50 to column 7, line 25) including a first copying mode (which reads on Image Input Function) in which the image signal outputted from the scanner is outputted to the printer using the external computer (8) (column 5, lines 65-68 and column 6, line 65 to column 7, line 7), and a second copying mode (which reads on Copy Function) performed in response to a single designation (which reads on when the Copy key is depressed) in which the image signal inputted from the scanner is outputted to the printer without using the external computer (column 6, lines

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50-55), the image signal output from the scanner being transmitted (which reads on under control of the personal computer or by computer programs) (column 5, lines 65-68; column 6, lines 65-67 and column 23, lines 12-32) in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), first bidirectional interface (5), the external computer (8), the first bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and the second bidirectional interface (66) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)) and the second bidirectional interface (66) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner).

Kita differs from claim 24 in that he does not clearly disclose that the first and second bidirectional interfaces are of a same standard.

Kawamata discloses a print system wherein all of the interfaces are standardized (column 1, line 67 to column 2, line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the first and second bidirectional interfaces are of a same standard. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kawamata in order to increase the processing speed.

With respect to claim 59, Kita discloses a density adjusting feature (figure 2, part 25).

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12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 24 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Menendez (U. S. 5,113,494).

With respect to claim 24, Kita discloses an image processing device (1) comprising a scanner (60) for inputting an image signal (column 5, lines 16-47); a control unit (which reads on 50, 51, 52, 54, 56, and buses (DB, AB, and CB)) including a control circuit (50) for controlling the device (column 4, lines 46-54) and performing necessary image processing on the image signal input from the scanner to provide a first processed image signal (column 5, lines 33-37); a first bidirectional general purpose interface (5) (column 6, lines 20-28) for transmitting the image signal input by the scanner (60) under control of the control unit (50) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); a second bidirectional interface (66) (which reads on for connecting a mechanism), for outputting the first and second signals to a printer (3), wherein the device has a plurality of modes (column 6, line 50 to column 7, line 25) including a first copying mode (which reads on Image Input Function) in

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which the image signal inputted from the scanner is outputted to the printer using the external computer (8) (column 5, lines 65-68 and column 6, line 65 to column 7, line 7), and a second copying mode (which reads on Copy Function) in which the image signal inputted from the scanner is outputted to the printer without using the external computer (column 6, lines 50-55), the image signal from the scanner being automatically transmitted (which reads on under control of the personal computer or by computer programs) (column 5, lines 65-68; column 6, lines 65-67 and column 23, lines 12-32) in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), first bidirectional interface (5), the external computer (8), the first bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and the second bidirectional interface (66) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)) and the second bidirectional interface (66) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner).

Kita differs from claim 24 in that he does not clearly disclose that the first and second bidirectional interfaces are of a same standard.

Menendez discloses a print system comprising various nodes (interfaces) 2_1 and 2_{k+1} connected to a bus (figure 1) wherein all of the nodes are identical (column 9, lines 41-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

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invention to have modified Kita wherein the first and second bidirectional interfaces are of a same standard. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Menendez in order to increase the processing speed.

With respect to claim 59, Kita discloses a density adjusting feature (figure 2, part 25).

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kawamata as applied to claim 24 above, and further in view of Kochis (U. S. 5,218,458).

With respect to claim 26, Kita as modified differs from claim 26 in that he does not clearly disclose that the computer has a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. Kochis discloses a system that transmits a data file between two computer systems via a telephone line (110, figure 1), utilizing PC fax cards (which reads on a modem) (column 2, lines 53-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified wherein the computer would have a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. It would have been

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obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified by the teaching of Kochis in order to be able to transfer files between computer systems as taught by Kochis in column 1, lines 6-7.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Menendez as applied to claim 24 above, and further in view of Kochis (U. S. 5,218,458).

With respect to claim 26, Kita as modified differs from claim 26 in that he does not clearly disclose that the computer has a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. Kochis discloses a system that transmits a data file between two computer systems via a telephone line (110, figure 1), utilizing PC fax cards (which reads on a modem) (column 2, lines 53-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified wherein the computer would have a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as

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modified by the teaching of Kochis in order to be able to transfer files between computer systems as taught by Kochis in column 1, lines 6-7.

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kochis et. al. (hereinafter referred to as Kochis) (U. S. 5,218,458).

With respect to claim 29, Kita differs from claim 29 in that he does not clearly disclose that the computer has a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. Kochis discloses a system that transmits a data file between two computer systems via a telephone line (110, figure 1), utilizing PC fax cards (which reads on a modem) (column 2, lines 53-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the computer would have a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kochis in order to be able to transfer files between computer systems as taught by Kochis in column 1, lines 6-7.

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20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kawamata as applied to claim 24 above, and further in view of Kenmochi (U. S. 5,900,947).

With respect to claim 58, Kita as modified differs from claim 58 in that he does not clearly disclose that the scanner generates a color image signal. Kenmochi discloses a communications apparatus wherein a color reading unit may be utilized (column 11, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified wherein the scanner would generate a color image signal. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified by the teaching of Kenmochi in order to output color data to the personal computer as disclosed by Kenmochi in column 12, lines 1-3.

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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23. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Menendez as applied to claim 24 above, and further in view of Kenmochi (U. S. 5,900,947).

With respect to claim 58, Kita as modified differs from claim 58 in that he does not clearly disclose that the scanner generates a color image signal. Kenmochi discloses a communications apparatus wherein a color reading unit may be utilized (column 11, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified wherein the scanner would generate a color image signal. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified by the teaching of Kenmochi in order to output color data to the personal computer as disclosed by Kenmochi in column 12, lines 1-3.

Response to Arguments

24. Applicant's arguments filed 6/7/2002 have been fully considered but they are not persuasive.

Applicant submits that Kita does not disclose that in the first copying mode, after the image has been processed by the external computer, the image processing device receives the image data and outputs the image data to a printer. The Examiner disagrees. Kita clearly states that the image data read by the scanner is transferred to the computer (8), then transmitted from the computer back to the image processing device (1) to be printed (column 5, lines 65-68).

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25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

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MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON